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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,772	08/18/2003	Meir Rosenberg	022719-0046	3663
21125	7590	12/21/2005	EXAMINER	
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			HOEKSTRA, JEFFREY GERBEN	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JP

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/642,772		ROSENBERG, MEIR	
	<b>Examiner</b>		<b>Art Unit</b>	
	Jeffrey G. Hoekstra		3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 28-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I in the reply filed on 12/09/05 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 28-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/09/05.

### ***Information Disclosure Statement***

3. The information disclosure statement(s) (IDS) submitted on 11/24/2003 and 12/05/2005 is/are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement(s).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-11, 13, and 15-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Fonger et al (5291896). For claims 1 and 18, Fonger discloses a catheter drainage system comprising an elongated tube 12 including a distally disposed

Art Unit: 3736

sensor 14 (column 6 lines 13-18), further including at least one wire 24 distally coupled to the sensor and proximally adapted 26 for electrical powering/ communication and extending along the length of the catheter in fluid isolation from the inner lumen 40 and wherein the at least one wire being proximally separable from the elongated tube through a slit 46 such that the tube length is selectively adjustable (column 2 lines 30-35 and column 4 lines 32-44)). Furthermore, the slit 46 extends through the outer wall 15 of the tube 12 into the second lumen 42 such that the at least one wire can be partially removed to adjust the tube length.

6. For claims 2 and 11, Fonger discloses the at least one wire 24 disposed within a second lumen 42 isolated from the first and wherein the slit 46 extends into the second lumen).

7. For claim 3, 6-10, and 21-24, Fonger discloses a slit 46 extending through the outer wall 15 of the tube 12 into the second lumen 42 such that the tube length is selectively adjustable (column 4 lines 32-44). The slit 46 is configured such that the at least one wire can be partially removed to adjust the tube length and when said wire(s) is/are inserted they are in substantial fluid isolation via the sealing action of the polymer. The slit 46 is configured (column 4 lines 6-10) to extend along a distance less than the length of the catheter and less than about one half the length of the catheter as best seen in Figure 1.

8. For claims 4 and 19, Fonger discloses a first lumen diameter greater than the second lumen diameter (column 3 lines 60-66).

Art Unit: 3736

9. For claims 5 and 20, Fonger discloses multiple secondary lumens 84,86,88,90 formed within an invagination of the outer tube wall 12 as best seen in Figure 7.

10. For claims 13 and 25, Fonger discloses the use of a flexible, biocompatible polymer (column 3 lines 41-42).

11. For claims 15-17 and 26-27, Fonger discloses a distally disposed pressure sensor (column 6 lines 13-18) adapted to sense physiological conditions adjacent to the elongated tube and disposed within the secondary lumen with an inner diameter of 10 French (column 3 lines 63-66) which is equal to approximately 3.3 mm or 0.131 inches.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fonger in view of Quackenbush (5104398). Fonger discloses the claimed sensor catheter drainage system except for the polymer selected from a group consisting of silicones, silicone-like materials, and polyurethanes and wherein the at least one wire is disposed within a secondary catheter coupled to the first that can be peeled apart to allow the catheter length to be adjusted independent the length of the secondary catheter. Quackenbush discloses a membrane splitting tube 10 comprised of polyurethane (column 3 line 23) with a catheter or wire inserted in an outer peel-away membrane (column 1 lines 33-41). It would have been obvious to one having ordinary

Art Unit: 3736

skill in the art at the time the invention was made to modify the system as taught by Fonger, with Quackenbush for the purpose of adjusting the length of a catheter or tube without removing the protective sheath surrounding electrical leads.

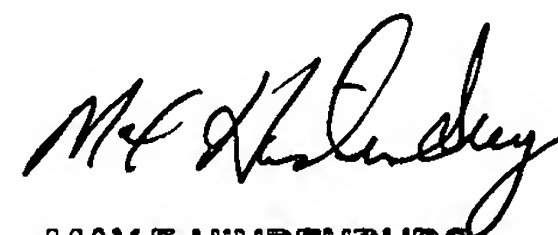
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGH



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